



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,342	04/11/2006	Jean-Francois Stumbe	288261US0PCT	3536
22850 7590 02/11/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER DOLLINGER, MICHAEL M				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 02/11/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/575,342

Applicant(s)

STUMBE ET AL.

Examiner

MICHAEL DOLLINGER

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 2-4 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-SB08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Applicant must choose one species (1) through (14), listed below, of the at least one compound having at least one ethylenic double bond. If species of (1) is elected, then Applicant must choose one of the following species (2)-(14) that falls within the genus of (1). The species are as follows:

(1) compound having a terminal double bond,

(2) compound of formula Ia

(3) compound of formula Ib

If species (2) or (3) is chosen, Applicant must pick one species of each of the following

i) R¹ must be selected from a) branched or unbranched C₁-C₁₀ alkyl or b) hydrogen

ii) R² must be selected from a) branched or unbranched C₁-C₁₀ alkyl, b) C₂-C₆ alkenyl, c) COOH or d) hydrogen

iii) X must be selected from a) halogen or b) OR³

iv) R³ must be selected from a) branched or unbranched C₁-C₁₀ alkyl with at least one functional group, b) polyethylene glycol derivatives and polypropylene

Art Unit: 1796

glycol derivatives, c) glycidyl, d) H-CO (formyl), e) branched and unbranched C₁-C₁₀ alkyl-CO and f) C₆-C₁₀ 10 aryl-CO

(4) unsaturated carboxylic acids having 3 to 30 carbon atoms and from 1 to 5 C=C double bonds

(5) unsaturated alcohols having 3 to 40 carbon atoms and from 1 to 5 C=C double bonds

(6) unsaturated amines having 3 to 20 carbon atoms and from 1 to 5 C=C double bonds

(7) diol and polyol ethers in which at least one hydroxyl group is etherified with an unsaturated alcohol and at least one hydroxyl group is unetherified

(8) diol and polyol esters in which at least one hydroxyl group is esterified with an unsaturated acid and at least one hydroxyl group is unesterified

(9) vinyl esters

(10) diene monoepoxides

(11) triene monoepoxides

(12) unsaturated halides having 2 to 20 carbon atoms and from 1 to 5 C=C double bonds

(13) isocyanato (meth)acrylates

(14) unsaturated halogenated silanes

If species (4), (5), (6) or (12) is chosen, Applicant must specify the number of double bonds present.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The claims are deemed to correspond to the species listed above in the following manner:

Species (1) corresponds to claim 2
Species (2) and (3) correspond to claim 3
Species (4) through (14) correspond to claim 4

The following claim(s) are generic: 1 and 5-9.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The common technical feature of the claims cannot be special because it is disclosed in the prior art. The common technical feature of the claims hyperbranched polyester obtainable by reacting (c) at least one compound having at least one ethylenic double bond with at least one hyperbranched polyester obtainable by condensing; (a) at least one

dicarboxylic acid or derivative thereof with at least one at least trifunctional alcohol; or (b) at least one tricarboxylic or higher polycarboxylic acid or derivative thereof with at least one diol. Raanby et al (US 5,834,118) disclose a radiation curable resin comprising a hyperbranched polyester wherein the polyester is obtained (a) reacting an aromatic polycarboxylic anhydride with 2 to 4 carboxyl groups with a polyol with 3 to 10 reactive hydroxyl groups (corresponding to the claimed step (a)) and (b) reacting the product of (a) with glycidyl (meth)acrylate (corresponding to the claimed step (c)) [column 3 lines 5-20]. Henceforth Raanby et al disclose the common technical feature of the claims and the present claims lack unity of invention.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL DOLLINGER whose telephone number is (571)270-5464. The examiner can normally be reached on Monday - Thursday 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796

MICHAEL DOLLINGER
Examiner
Art Unit 1796

/mmd/